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10/015,378	12/12/2001	James Sheung Lau	CA920000074US1	2828

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EXAMINER

ELMORE, JOHN E

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,378

Applicant(s)

LAU, JAMES SHEUNG

Examiner

John Elmore

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-39 have been examined.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. CA02328644, filed on 12/15/2000.

Objections to Specification

3. The disclosure is objected to because of the following informalities: the term "apple" (pages 2, 7, 8, 10 and 11) presumably should read "applet" or something comparable to a computer program. Appropriate correction is required.

Claim Objections

4. Claims 4, 5 and 31 are objected to because of the following informalities: the term "apple" presumably should read "applet". Appropriate correction is required.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-3, 6-13, 16-20, 29, 30 and 32-39 are rejected under 35 U.S.C. 102(b)** as being anticipated by Ginter (US 5,892,900).

Regarding claim 1, Ginter discloses a method comprising:

embedding in said computer readable content (VDE object 300) instruction codes (VDE 100; in particular, PPE 650 and other SPU 500 processes) operable to direct a processor circuit (electronic appliance 600) to automatically establish a connection to a server (VDE administrator or clearinghouse), when said content is in use by said processor circuit, to transmit registration information to said server (ROS 602, embedded with distribution of content, automatically registers content object 300; col. 7, lines 35-48; col. 9, lines 33-58; col. 13, lines 50-67; col. 17, lines 42-44; col. 60, lines 6-16; col. 134, lines 1-14; col. 160, lines 35-64; col. 168, line 1, through col. 169, line 67; col. 307, lines 24-30; col. 314, line 62, through col. 315, line 25) and

operable to control further use of said content by said processor circuit in response to a key received from said server (content key decrypts content in object 300 for registered users; col. 21, lines 48-59; col. 68, lines 1-27; col. 136, lines 9-28; col. 189, line 44, through col. 190, line 36; col. 199, lines 33-65; col. 206, line 26, through col. 208, line 16; col. 217, lines 51-65; col. 223, lines 6-11).

Regarding claim 2, Ginter teaches all the limitations of claim 1, and further teaches storing said computer readable content and said embedded instruction codes on a portable memory medium (e.g. CD-ROM; col. 18, lines 6-21; col. 55, lines 24-31).

Regarding claim 3, Ginter teaches all the limitations of claim 1, and further teaches providing said computer readable content and said embedded instruction codes for use by a user computer (use by electronic appliance 600 which is a user computer; col. 60, line 8, through col. 61, line 34; col. 62, lines 31-37; col. 303, lines 41-50).

Regarding claim 6, this is equivalent to claim 3, with the further limitation that the computer readable content and instruction codes are provided to the user computer. Ginter teaches all the limitations of claim 3, and further teaches that the computer readable content and instruction codes are provided to the user computer (e.g. directly via distribution over a communications network to user computer; col. 3, lines 22-25; col. 18, lines 6-10; or indirectly via CD-ROM; col. 18, lines 6-21; col. 55, lines 24-31).

Regarding claims 7-9, such claims are rejected on the same basis as provided for claim 6.

Regarding claim 10, such claim is rejected on the same basis as provided for claim 1.

Regarding claim 11, Ginter teaches all the limitations of claim 10, and further teaches that executing comprises causing said instruction codes to be executed when access is made to said content by said processor circuit (a process of the SPU 500/ROS 602 executes to enforce usage permissions PERC 808 as defined by the electronic contract 3200 when content is accessed by user; col. 26, lines 37-65; col. 61, lines 18, through col. 62, line 18; col. 155, lines 52-63; col. 169, lines 41-48; col. 176, lines 32-57; col. 273, lines 9-39).

Regarding claim 12, Ginter teaches all the limitations of claim 10, and further teaches that executing comprises producing a measure of use of said content by said processor circuit (metering; col. 13, lines 46-49; col. 23, lines 37-44; col. 47, lines 64-66).

Regarding claim 13, Ginter teaches all the limitations of claim 12, and further teaches producing said measure of use of said content comprises determining a number of times said content is accessed by said processor circuit (use counter; col. 150, line 44, through col. 153, line 28; col. 317, lines 43-46).

Regarding claim 16, Ginter teaches all the limitations of claim 12, and further teaches establishing said connection to said server when said measure of use exceeds a threshold value (usage exceeds budget threshold; col. 168, lines 9-34).

Regarding claim 17, Ginter teaches all the limitations of claim 16, and further teaches that establishing said connection comprises establishing an internet protocol connection with said server (it is inherent that a connection with a server over the internet (electronic superhighway 108) uses internet protocol; col. 168, lines 13-15; col. 307, lines 6-30 and 61-67).

Regarding claim 18, Ginter teaches all the limitations of claim 17, and further teaches comprising launching a browse session with a uniform resource locator pointing to a user registration page for permitting a user to enter registration information (col. 315, lines 26-29).

Regarding claim 19, Ginter teaches all the limitations of claim 17, and further teaches that controlling subsequent use of said content comprises enabling subsequent use of said content when said key is received from said server (content key decrypts content in object 300; col. 21, lines 48-59; col. 68, lines 1-27; col. 189, line 44, through col. 190, line 36; col. 199, lines 33-65; col. 206, line 26, through col. 208, line 16; col. 217, lines 51-65; col. 223, lines 6-11).

Regarding claim 20, such claim is rejected on the same basis as claim 19 (it is inherent that the encrypted content is disabled from use where no key is received with which to decrypt the content).

Regarding claim 29, this is a computer-readable-medium version of the claimed method above (claim 1), wherein all limitations have been addressed. Therefore, for reasons applied above, such a claim also is anticipated.

Regarding claim 30, this is a data-signal version of the claimed method above (claim 1), wherein all limitations have been addressed. Therefore, for reasons applied above, such a claim also is anticipated.

Regarding claim 32, this is a system version of the claimed method above (claim 1), wherein all limitations have been addressed. Therefore, for reasons applied above, such a claim also is anticipated.

Regarding claim 33, Ginter teaches all the limitations of claim 32, and further teaches that said receiver (I/O controller 660 of electronic appliance 600) includes a media reader (e.g. electronic appliance includes a CD-ROM reader; Fig. 8; col. 62, lines 51-67; col. 63, lines 13-16).

Regarding claim 34, Ginter teaches all the limitations of claim 32, and further teaches that said communications interface (communications controller 666 of electronic appliance 600) is operable to establish communications on a network (col. 63, lines 2-5).

Regarding claim 35, Ginter teaches all the limitations of claim 32, and further teaches that said processor circuit (CPU 654) is part of a personal computer (electronic appliance 600) (col. 60, lines 8-9 and 58-61; col. 62, lines 32-37).

Regarding claim 36-39, this is a system version of the claimed method above (claims 25-28), wherein all limitations have been addressed. Therefore, for reasons applied above, such a claim also is anticipated.

6. **Claims 10, 12, 15, 20 and 21 are rejected under 35 U.S.C. 102(e)** as being anticipated by Stefik et al. (US 6,236,971), hereafter Stefik.

Regarding claim 10, Stefik discloses a method comprising:
executing instruction codes (usage rights) embedded in said computer readable content, when said content is in use by a processor circuit (processor 1201 of repository 201), to automatically establish a connection to a server (authorizing repository 202 and credit server 301) to transmit registration information to said server (repository 201 executes usage rights embedded with content in response to user request to access content; col. 9, lines 14-26; col. 26, lines 14-37; col. 27, lines 20-28; col. 29, lines 20-49; col. 30, lines 15-16) and

to control subsequent use of said content by said processor circuit in response to a key (digital ticket) received from said server (col. 8, lines 1-7; col. 14, lines 65-67; col. 30, lines 64-67; col. 31, lines 16-24).

Regarding claim 12, Stefik teaches all the limitations of claim 10, and further teaches that executing comprises producing a measure of use of said content by said processor circuit (Table 1; col. 7, lines 32-42; col. 10, lines 28-38; col. 46, lines 14-15).

Regarding claim 15, Stefik teaches all the limitations of claim 12, and further teaches that producing said measure of use comprises determining document usage by function descriptive content (interpreter) in said computer readable content (metering of documents; Table 1; col. 6, lines 46-50; col. 47, lines 64-66).

Regarding claim 20, Stefik teaches all the limitations of claim 10, and further teaches that controlling subsequent use of said content comprises disabling further use of said content when no key is received from said server (content unusable without key; col. 31, lines 21-24).

Regarding claim 21, Stefik teaches all the limitations of claim 20, and further teaches deleting files (digital work reproducible by player) produced by functional descriptive content (player) in said computer readable content (digital work is deleted after usage rights to play are exhausted; col. 35, line 65, through col. 36, line 31).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 4, 5, 25-28 and 31 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Ginter.

Regarding claim 4, Ginter teaches all the limitations of claim 1, but Ginter does not explicitly explain that embedding composes embedding a self-executing applet in said computer readable content.

However, Ginter teaches that the instruction codes (an SPU 500/ROS 602 process) operate on the user computer (electronic appliance 600) in order to securely enforce the usage permissions (electronic contract 3200) accepted at registration and that such enforcement of the contract is self-executing (col. 19, lines 34-45; col. 25, lines 43-57; col. 26, lines 37-65; col. 60, lines 15-16; col. 63, lines 28-44; col. 176, lines 32-57; col. 273, lines 9-39). Further, as Wikipedia defines an applet as “a small program that runs in the context of a larger program on a client computer,” it follows that one of ordinary skill in the art would recognize a process launched by the SPU 500 to enforce the usage permissions as an applet. Therefore, the Examiner takes official notice that it would be obvious that embedding composes embedding a self-executing applet in said computer readable content for the motivation of securely enforcing usage permissions of content provided to the user.

Regarding claim 5, such claim is rejected on the same basis as provided for claim 4.

Regarding claim 25, the teaching of Ginter is relied upon as applied to claim 1, but Ginter does not explicitly explain that the key is operable to cooperate with said user

computer to deactivate execution of instruction codes embedded in said computer readable content at said user computer.

However, Ginter teaches that the instruction codes (VDE 100; in particular, PPE 650 and other SPU 500 processes) embedded in said computer readable content (VDE object 300) at said user computer (electronic appliance 600) contain "false" executable code that disables the execution of the PPE 650, thereby preventing access to the content, for the purpose of protecting the content against unauthorized use (col. 238, lines 50-54; col. 239, lines 2-4). One of ordinary skill in the art would recognize that normal operation of the instruction codes would require that the false executable code be deactivated via the key received upon proper registration by a user in order to prevent the PPE 650 from being disabled. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made that the key is operable to cooperate with said user computer to deactivate execution of instruction codes embedded in said computer readable content at said user computer for the motivation of protecting the content against unauthorized use.

Regarding claim 26, Ginter teaches all the limitations of claim 25, and further teaches comprising launching a browse session with a uniform resource locator pointing to a user registration page for permitting a user to enter registration information (col. 315, lines 26-29). Therefore, for reasons applied above, such a claim also would have been obvious.

Regarding claim 27, Ginter teaches all the limitations of claim 26, and further teaches validating said registration information (col. 166, lines 28-49; col. 169, lines 41-

57; col. 184, line 32, through col. 185, line 4). Therefore, for reasons applied above, such a claim also would have been obvious.

Regarding claim 28, Ginter teaches all the limitations of claim 26, and further teaches executing the act of transmitting when said registration information is successfully validated (col. 169, lines 57-64; col. 185, line 64, through col. 186, line 16). Therefore, for reasons applied above, such a claim also would have been obvious.

Regarding claim 31, this is a data-signal version of the claimed method above (claim 4), wherein all limitations have been addressed. Therefore, for reasons applied above, such a claim also would have been obvious.

9. **Claims 14, 15 and 22 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Stefik.

Regarding claim 14, Stefik teaches all the limitations of claim 12, and further teaches producing said measure of use comprises determining usage of functional descriptive content (interpreter) in said computer readable content (metered use, Table 1; col. 6, lines 46-50; col. 47, lines 64-66). But Stefik does not explicitly explain that usage is determined by memory usage. However, the Examiner takes official notice that it would be obvious to one of ordinary skill in the art at the time of the invention that usage is determined by memory usage for the motivation that memory usage is a simple and effective means for counting when a digital work is in use, particularly where use is permitted at a metered rate, noting that the mere presence of a copy of a work on

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a hard drive, for instance, would not readily indicate the time duration the work has been used while monitoring the memory usage of an interpreter would.

Regarding claim 22, Stefik teaches all the limitations of claim 22, but does not explain warning a user of said processor circuit that files are about to be deleted. However, Stefik teaches that the processor circuit interacts with the user through a graphical user interface (col. 16, lines 33-42). And it is widely known in the art that computers running graphical user interfaces will display a warning to the user that files are about to be deleted. Therefore, the Examiner takes official notice that it would be obvious to one of ordinary skill in the art to warn a user of said processor circuit that files are about to be deleted for the motivation of informing a user about data operations that may impact a user's decision-making.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Elmore whose telephone number is 571-272-4224. The examiner can normally be reached on M 10-8, T-Th 9-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 571-272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JE


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